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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

21X
130

In re Application of: Ole K. Nilssen
Entitled: INVERTER CIRCUITS
Serial Number: 06/787,692
Filing Date: 10/16/85
Art Unit: 212
Examiner: WILLIAM H. BEHA

I, OLE K. NILSSEN, HEREWITH CERTIFY THAT THE DATE OF DEPOSIT WITH THE U.S. POSTAL SERVICE OF THIS PAPER OR FEE IS: 09-09-86

Ole K. Nilssen 9-178

APPEAL BRIEF

86-3439

47/Brief

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Pursuant to Notice of Appeal, Applicant herewith provides a Brief in accordance with 37 U.S.C. 1.192.

Enclosed is a check (#1089) in the amount of $65.00 to cover the requisite fee.

At issue is the propriety of rejection by Examiner on basis of 35 U.S.C. 103 of claims 130-135. Three copies of these claims are enclosed.

Claims 130 and 134 were rejected under 35 U.S.C. 103 as being unpatentable over Rhoads in view of Walden and Elms, all of record; and claims 130 and 134-135 were similarly rejected over Rhoads in view of Steigerwald et al., also of record.

In addition, claims 130-135 were rejected under 35 U.S.C. 112, second paragraph.

Three copies of the drawings of subject application are also enclosed.

Exam Answer due 9-10-86

PRO SE APPLICANT

It is emphasized that subject application and appeal are being prosecuted by Applicant without the benefit of counsel.

CONCISE EXPLANATION OF INVENTION

The claimed invention is illustrated in Fig. 1 and constitutes a power supply arrangement comprising:

a) rectifier means (28 and 31) connected with an ordinary 120Volt/60Hz power line by way of a pair of AC input terminals (33 and 37) and operative to provide a (voltage-doubled) DC output voltage at a (center-tapped) DC output, the DC output voltage being provided between: i) terminal 38 (the B+ terminal), ii) terminal 39 (the B- terminal), and iii) terminal 37 (the center-tap or neutral terminal); and

b) an inverter circuit, which principally consists of: i) switching transistors 42 and 43, ii) saturable positive feedback current transformers 47 and 49, and iii) an L-C tank circuit consisting of inductor 51 and capacitor 52;

the inverter circuit being: i) connected with the (center-tapped) DC output, ii) operative to provide a sinusoidal output voltage of relatively high frequency (see Fig. 3D) across a pair of AC output terminals;

the AC output terminals being the terminals of the capacitor (52), one of which output terminals being connected with one of the AC input terminals (37);

the L-C tank circuit being resonant at or near the relatively high frequency.

AUTHORITIES

In connection with this appeal, Applicant makes reference to the following court interpretations (Authorities) relative to patentability under 35 U.S.C. 103. Of these Authorities, #1-#6 were provided to Applicant by the Assistant Commissioner for Patents and represented by him as being the Authorities relied upon by the PTO in determining patentability under 35 U.S.C. 103.

#1. "patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified" (In re Sponnoble, 405 F.2d 578, 160 USPQ 237, 1969);

#2. "A patentable invention within the ambit of 35 U.S.C 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

#3. "Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquiries should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution" (In re Roberts, 470 F.2d 1399, 176 USPQ 313, 1973);

#4. "we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243, 1969);

#5. "If there is no evidence that a person of ordinary skill in the art at time of applicant's invention would have expected problem to exist at all, it is not proper to conclude that invention which solves this problem, which is claimed as an improvement of prior art device, would have been obvious to that hypothetical person". (In re Nomiya, 184 USPQ 608, 1975)

#6. "There must be a reason apparent at time invention was made to person of ordinary skill in the art for applying the teaching at hand, or use of teaching as evidence of obviousness will entail prohibited hindsight". (In re Nomiya, 184 USPQ 608, 1975)

#7. In Richdel, Inc. v. Sunspool Corp. (714 F.2d 1573 -- Fed Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for the purpose of determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements".

#8. In Adams (356 F.2d 998 -- CCPA 1966), the Board (of Appeals) was reversed because "neither reference contains the slightest suggestion to use what it discloses in combination with what is disclosed in the other." (356 F.2d at 1002)

#9. In Imperato (486 F.2d 585 -- CCPA 1973): although combining the references' teachings yielded the result claimed, the CCPA held that the combination was not obvious "unless the art also contains something to suggest the desirability of the combination".

#10. In Sernaker (702 F.2d at 995-96), the CAFC interpreted Imperato to mean that "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".

#11. In Environmental Design (713 F.2d at 698), the CAFC stated: "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant" [to obviousness].

#12. In Fromson v. Advance Offset Plate (755 F.2d 1556), the CAFC stated as follows. (Underlining by Applicant)

"Where, as here, nothing of record plainly indicates that it would have been obvious to combine previously separate process steps into one process, it is legal error to conclude that a claim to that process is invalid under paragraph 103."

#13. In Kimberly-Clark Corporation v. Johnson & Johnson (745 F.2d at 1449), the CAFC stated as follows. (Underlining by Applicant)

"examining all the references of record, we fail to find a clear suggestion of the claimed subject matter. ---- The holding of invalidity on ground of obviousness is therefore reversed.".

#14. In Kansas Jack (719 F.2d at 1144), the CAFC stated that "one may not use the teachings of the present invention as a guide to interpretation of the prior art".

ARGUMENTS IN SUPPORT OF APPEAL

In Re Independent Claim 1

Claim 1 may be considered exemplary.

Examiner rejected claim 1 under 35 U.S.C. 103 as being unpatentable over Rhoads in view of Walden and Elms.

Applicant traverses this rejection for the following reasons.

a) In view of Authority #5, Examiner has not provided evidence of a problem for which the claimed invention constitutes a solution; and, of course, without evidence of pre-existing awareness by person of ordinary skill on the art of such a problem, it is meaningless to classify an invention which solves that problem as being obvious.

That is, Examiner has not provided evidence with respect to obvious motivation for a person of ordinary skill in the art to seek to attain the claimed invention.

In the fourth paragraph on page 3 of his office action dated 06/10/86, Examiner makes the following statement with respect to motivation:

"it would have been obvious to use a voltage multiplier/full wave rectifier arrangement feeding an inverter for use with diverse input voltage sources".

This statement constitutes an unsupported assertion.

In view of Authority #8, there is no suggestion in any one of the applied references to the effect that it would be advantageous to use what it discloses in combination with what is disclosed in the other two references.

In other words, Examiner has not provided evidence of motivation.

b) Particularly in view of Authorities #12 and #13, not one of the applied references contains a plain or clear suggestion to the effect that it would be advantageous to combine its teachings with the teachings of the other references.

In Re "112" Rejections

Applicant traverses these rejections for the following reasons.

Again using claim 1 as an example, it is clear that the claimed invention is expressed in claim 1 as a combination of two elements, both of which are expressed in the well-accepted format of MEANS AND FUNCTION.

The first element of claim 1 describes a "rectifier means" together with its connections (connected with an ordinary electric utility power line by way of a pair of AC input terminals, etc.) and its function (operative to provide a DC voltage at a DC output, etc.).

The second element of claim 1 describes an "inverter circuit" (a means) together with its function (to provide a sinusoidal output voltage at a pair of AC output terminals, etc.) and its connections (one of its AC output terminals being connected with one of the AC input terminals, etc.).

When interpreted in light of the specification, there is no doubt in Applicant's mind but that claim 1 is clearly understandable by a person having ordinary skill in the art.

In Re Claims 131-135

In substance, the arguments provided hereinabove in connection with claim 1 pertain to claims 131-135 as well.

Reference to Previous Arguments by Applicant

Attached hereto are copies of pages 3-10 of Applicant's response to Examiner's office action dated 12/09/85.

The remarks provided on those pages have direct relevance to instant Appeal and are herewith incorporated into instant Appeal Brief.

CONCLUDING REMARKS

In view of the arguments provided hereinabove, it is clear that Examiner erred in rejecting the claims at issue.

In case of questions, the Chief Examiners are invited to call Applicant on the telephone, thereby to attempt to reach a mutually acceptable disposition of subject application in a cost-effective manner.

Ole K. Nilssen, Applicant

Date: 9-4-86

312-568-5615